

Applicant: Boulineau et al.
Serial No.: 10/680,658

PATENT
Atty Docket No.: 10-9429

REMARKS

This Amendment is filed in response to the Official Action dated November 9, 2004. In this Amendment, Claims 1-34 are amended, Claims 35-36 are canceled, and Claims 37-45 are added. Of these claims, Claims 1, 22, 32, and 37 are independent. No new matter has been entered by these new claims. Following entry of this amendment, Claims 1-45 shall be pending.

I. OBJECTIONS TO THE DRAWINGS

The Examiner has rejected Figure 1 noting that it should be labeled "Prior Art." Accordingly, the Applicant has provided a replacement sheet of drawings so labeled.

II. SPECIFICATION

The Examiner has noted that the specification references five Japanese applications and incorporates them by reference. In response thereto, the Applicant has rewritten paragraph [0013] of the specification so that the Japanese applications are no longer incorporated by reference.

III. REJECTIONS UNDER 35 U.S.C. SECTION 102

Claims 1-7, 9, 11-14, 22, 24, 26-30, and 32-34 are rejected under 35 U.S.C. Section 102(b) as being anticipated by US Patent 6,145,984 to *Farwig*. Applicant respectfully traverses these rejections as set forth below.

The invention of Claim 1, as amended, relates to an optical element having an outer side and an inner side, said first layer having a first size; a second, functional layer having a second size; said second, functional layer disposed adjacent said inner side of said first layer; and, wherein said second size is smaller than said first size. Thus, the functional layer is smaller than the

Applicant: Boulineau et al.
Serial No.: 10/680,658

PATENT
Atty Docket No.: 10-9429

first layer. Due to the size difference between the first layer and the second, functional layer, the functional layer does not bleed when subjected to the heat encountered during the injection molding process.

The optical element in *Farwig*, on the other hand, is configured such that the inner layers are slightly larger than the outer layers. This is contrary to the claimed invention where the functional layer is ***smaller*** than the first (or outer) layer. Moreover, the purpose of the size relationship of the layers in *Farwig* is unrelated to the purpose of the size relationship of the layers in the claimed invention. The purpose in *Farwig* is to provide an element that can fit into a sunglass frame whereas the purpose in the claimed invention is to prevent bleeding of the functional layer when used to make an injection molded lens. *Farwig* does not address bleeding at all. Indeed, using the *Farwig* structure to make an injection molded lens as suggested by *Farwig* in Col.7, line 49 would result in the very problem the present invention is seeking to avoid. Thus, one skilled in the art would not look to *Farwig* to solve the problem confronted by the present invention. Withdrawal of the rejection of Claim 1 is thus requested.

The invention of Claim 22, as amended, relates to a method of making an optical element by providing a first layer having a lamination side and a non-lamination side; providing a second layer substance, said second layer substance being functional; and, configuring said second layer functional substance against said lamination side of said first layer such that a size of said second layer functional substance is less than a size of said first layer.

The Examiner has cited *Farwig*'s Figure 4 in rejecting Claim 22. However, *Farwig*'s Figure 4 specifically pertains to a ***non-laminated*** element. Thus, the *Farwig* element does not have a first layer with a lamination side. Rather, the element in *Farwig* is merely a lens that has coatings. The withdrawal of the rejection of Claim 22 is thus requested.

Applicant: Boulineau et al.
Serial No.: 10/680,658

PATENT
Atty Docket No.: 10-9429

The invention of Claim 32, as amended, relates to a functional wafer that is insertable into a mold for use in making an injection molded lens. *Farwig* relates to completed lenses. This is evidenced in Col. 5, lines 5-9 of *Farwig* where the term "lens element" is defined as "lenses formed of ground and polished mineral glass, crystal, or optical-grade plastic; molded and/or extruded plastic lenses; and flat plastic which is cut and formed into lenses of a desired shape. *Farwig* does not use the term "lens element" to include wafers for use in making a lens. Moreover, each of the embodiments depicted in the Figures of *Farwig* depict lenses, not wafers insertable into a mold. One skilled in the art would not look to *Farwig* as a reference related to making functional wafers insertable into a mold for use in making an injection molded lens. Withdrawal of the rejection of Claim 32 is hereby requested.

As a result, it is respectfully submitted that *Farwig* cannot continue to be properly asserted as anticipating amended Claims 1, 22 and 32 of the present invention. It is further submitted that *Farwig* cannot be properly asserted as rendering Claims 1, 22 and 32 obvious. Accordingly, it is submitted that Claims 1, 22 and 32 are now allowable over the cited prior art.

With respect to Claims 2-7, 9, 11-14, 24, 26-30, and 33-34, these claims variously depend from independent Claims 1, 22 and 32, and thus are submitted as allowable for at least the reasons set forth above. However, these claims further define and describe the presently claimed invention and thus are patentable over and above their precursor independent claims.

IV. REJECTIONS UNDER 35 U.S.C. SECTION 103

Claim 10 has been rejected under § 103(a) as being unpatentable over *Farwig* (Figure 4) in view of *Farwig* (Figure 2). Applicant respectfully submits that Claim 10, being dependent from Claim 1, is patentable for at least the reasons set forth above with respect to Claim 1. Applicant also submits that Claim 10 is independently patentable over *Farwig*. Claim 10, as amended, relates to an

Applicant: Boulineau et al.
Serial No.: 10/680,658

PATENT
Atty Docket No.: 10-9429

optical element having a first and third layer of substantially equal diameters on either side of a second, function layer having a smaller diameter. Neither Figure 4 nor Figure 2 in *Farwig* depicts such a lens element. Figure 4 of *Farwig* not only has a middle layer that is larger than the outside layers, *Farwig* specifically states at Column 8, lines 16-28 that Figure 4 depicts a non-laminated, single lens having various coatings on the concave and convex surfaces. Thus, *Farwig* Figure 4 does not, as Examiner states, disclose an optical element of the present invention, failing only to disclose that the third size diameter is the same as the first size diameter. Figure 2 depicts a laminated lens having a middle functional layer between two outer layers, all of which appear to have the same diameter. Figure 2 of *Farwig* fails to show a functional second layer having a second size, wherein the second size is smaller than said first size. Thus, this rejection of Claim 10 is respectfully traversed.

Claims 8, 15-21, 23, 25, 31, and 35-36 are rejected under § 103(a) as being unpatentable over *Farwig* (Figure 4) in view of *Robran* et al. Claims 35-36 are now cancelled. Applicant respectfully submits that Claims 8, 15-21, 23, 25, 31, as amended, are patentable for at least the reasons stated above with respect to their precursor claims. However, all of these claims are independently patentable over *Farwig* and *Robran* et al. For example, as discussed above, *Farwig* (Figure 4) pertains to a single, non-laminated, coated lens rather than a laminated lens element. Nor does *Robran* teach or disclose a lens element with a first layer and a second, functional layer having a size smaller than that of the first layer. Rather, *Robran* teaches molding a ski goggle frame around a completed lens. Because neither reference relates to a wafer useable in the injection molding process for forming a lens, each of the rejected claims in view of these to references is independently patentable.

Applicant: Boulineau et al.
Serial No.: 10/680,658

PATENT
Atty Docket No.: 10-9429

IV. NEW CLAIMS

Claims 37-45 are added in this Amendment. Claim 37 is independent and pertains to a method of forming a lens having a functional layer by providing a first layer; providing a functional layer smaller in size than the first layer; forming a wafer by laminating the functional layer to the first layer such that a space is formed between an outer edge of the first layer and an outer edge of the functional layer; placing the wafer in a mold; and injecting molten lens material into the mold to form a lens. None of the prior art cited by the Examiner discloses or suggests a method including these steps. As stated above, neither *Farwig* nor *Robran et al.* is directed to a solution to the problems associated with functional layers, such as polarizing layers, bleeding when exposed to the heat of an injection molding process. Thus, it is respectfully submitted that Claim 37 is patentable over the prior art. Claims 38-45 depend from Claim 37. Immediate allowance of these claims is respectfully requested.

Applicant: Boulineau et al.
Serial No.: 10/680,658

PATENT
Atty Docket No.: 10-9429

CONCLUSION

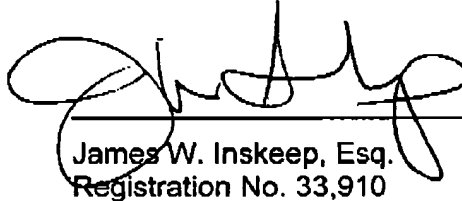
In view of the foregoing, it is submitted that pending Claims 1-34, and 37-45 are now in condition for allowance. Hence an indication of allowability is hereby requested.

If for any reason direct communication with Applicants' attorney would serve to advance prosecution of this case to finality, the Examiner is cordially urged to call the undersigned attorney at the below listed telephone number.

The Commissioner is authorized to charge any fee which may be required in connection with this Amendment to deposit account No. 50-2809.

Respectfully submitted,

Dated: April 5, 2005


James W. Inskeep, Esq.
Registration No. 33,910

INSKEEP INTELLECTUAL PROPERTY GROUP, INC.
1225 W. 190th Street, Suite 205
Gardena, CA 90248
Telephone: (310) 217-6220
Facsimile: (310) 327-0282

Customer No. 37,374